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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/522,842

01/28/2005

Zheng Lu

LCS-103/PCT/US

1886

31217 7590 09/05/2008

LOCTITE CORPORATION
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EXAMINER

PENG, KUO LIANG

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

09/05/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/522,842	LU ET AL.	
	Examiner	Art Unit	
	Kuo-Liang Peng	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 7/7/08 Response.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6,9,12,21,23 and 38-51 is/are pending in the application.
- 4a) Of the above claim(s) 44-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6, 9, 12, 21, 23, 38-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/2/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed July 7, 2008 has been entered. Claims 1, 6, 9, 12, 21, 23 and 38-39 are amended. Claims 2-5, 7-8, 10-11, 13-20, 22 and 24-37 are deleted. Claims 40-51 are added.

2. Newly submitted Claims 44-51 are directed to inventions that are independent or distinct from the invention originally claimed for the following reasons: Invention of Claims 44-49 and Invention of the previously presented claimed are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product can be prepared from a single part, instead of three separate parts. Furthermore, Invention of Claims 50-51 and

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Invention of the previous presented claims are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product can be used for coating any substrate other than a mold surface. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Claims 44-51 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Now, Claims 1, 6, 9, 12, 21, 23 and 38-43 are pending for consideration.

3. Claim rejection(s) under 35 USC 102 and/or 103 in the previous Office Action (Paper No. 20080202) is/are removed.

Claim Rejections - 35 USC § 102 and 103

4. Claims 1 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Giraud (WO 01/40417).

The following column and line numbers are based on Giraud's U.S. equivalent, US 6 825 153.

For Claims 1, 6, 9, 12, 38, 40 and 41-43, Giraud discloses a composition comprising components a) to f) and optionally components g) and h) (both are hydroxyl end-capped polysiloxanes). Note that components b) and c) can contain amine moiety, which are thus considered as bases. (col. 2, lines 32-67, col. 4, lines 9-11 and col. 6, line 65 to col. 7, line 32, col. 9, line 57 to col. 10, line 67) A thickener can be used. (col. 11, lines 5-12) Giraud is silent on the pH of the composition, the amount of VOC, the shelf life and the . However, the reference discloses all the limitations of a claim except the properties, and the examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant as in *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). The preamble "mold release composition" is merely an intended use, which does not carry any weight of patentability.

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5. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Giraud

Giraud discloses a composition, *supra*, which is incorporated herein by reference. Giraud is silent on the claimed viscosity. However, the viscosity of the composition can affect the coating process, thickness per coating, etc. As such, the viscosity is a Result-Effective variable. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a composition with whatever viscosity through routine experimentation in order to afford a coating with desired properties. Especially, Applicants do not show the criticality of the viscosity. See MPEP 2144.05 (II).

6. Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Giraud and further as evidenced by Hyde (US 2 891 920).

Giraud discloses a composition, *supra*, which is incorporated herein by reference. Giraud further teaches that the polysiloxanes in Hyde can be employed as component h) (col. 10, lines 62-67). Thus, Hyde teaches the polysiloxanes having viscosities falling within the claimed range. (col. 4, lines 65-72 and Examples)

7. Claim 39 is rejected under 35 U.S.C. 103(a) as obvious over Giraud.

Giraud discloses a composition, *supra*, which is incorporated herein by reference. Giraud is silent on the amounts of the components set forth in the instant claim. However, the amounts of the components will affect the viscosity and/or the curing rate of the composition and/or the final properties of the cured product. As such, the amounts are Result-Effective variables. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a composition with whatever amounts of the ingredients through routine experimentation in order to afford a composition with desired viscosity, curing rate and properties. Especially, Applicants do not show the criticality of the amounts. See MPEP 2144.05 (II).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck, can be reached on (571) 272-1078. The fax

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phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp
September 2, 2008

/Kuo-Liang Peng/
Primary Examiner, Art Unit 1796